

C. REMARKS

Status of the Claims

Claims 1, 3-8, 10-14, and 16-20 are currently present in the Application, and claims 1, 8, and 14 are independent claims. Claims 1, 3, 4, 8, 10, 11, 14, 16, and 17 have been amended, claims 2, 9, and 15 have been cancelled, and no claims have been added.

Examiner Interview

Applicants wish to thank the Examiner for the courtesy extended to Applicants' attorney during a telephone interview on Friday, June 9, 2006. During the interview, Applicants' attorney discussed independent claims 1, 8, and 14 with regard to the Band and Haq references. Applicants' attorney noted that neither Band nor Haq discloses selecting an employee for **surplus evaluation**, and then **evaluating the selected employee** using a retrieved evaluation template. See the discussion below for further details. No agreement was reached on the claims during the interview.

Drawings

The Office Action did not indicate whether the formal drawings filed by the Applicants are accepted by the Examiner. Applicants respectfully request that the Examiner indicate whether the drawings filed on January 8, 2002 are accepted by the Examiner in the next communication.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants

regard as the invention. Independent claims 1, 8, and 14 have been amended to claim "creating one or more evaluation templates," thus correcting the antecedent basis issue in these claims. Dependent claims 3, 4, 10, 11, 16, and 17 have also been amended to be consistent with the independent claims. Based on these amendments, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 112, second paragraph.

Claim Rejections - Alleged Obviousness Under 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "Strategic Downsizing" by Band et al. (hereinafter Band) in view of Haq et al., U.S. Patent No. 6,275,812 (hereinafter Haq). Applicants respectfully traverse the rejections under 35 U.S.C. § 103.

Note that independent claim 1 has been amended to include limitations previously found in dependent claim 2, and claim 2 has been cancelled. Similarly, independent claims 8 and 14 have been amended to include limitations previously found in dependent claims 9 and 15, respectively, and thus claims 9 and 15 have been cancelled. Using amended, independent claim 1 as an exemplary claim, Applicants' independent claims include the following elements:

- identifying a surplus skill group;
- creating one or more evaluation templates for the identified skill group, wherein each evaluation template includes one or more review factors;
- storing the evaluation templates in a data store;
- selecting an employee for surplus evaluation;

- retrieving employee data corresponding to the selected employee, wherein the employee data includes a skill group for the selected employee;
- locating one of the evaluation templates corresponding to the retrieved skill group;
- evaluating the selected employee using the located evaluation template;
- storing the evaluation of the selected employee in a second data store.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (Manual of Patent Examining Procedure § 2143.03). Band discusses strategic downsizing within an organization. Haq purports to teach a method for optimizing the assignment of employees to positions based upon a multi-factored analysis (col. 1, lines 5-9). However, neither Band nor Haq nor a combination of the two teaches or suggests Applicants' unique method, system, and computer program product for reducing employee resources through a planned resource reduction.

Applicants teach and claim "selecting an employee **for surplus evaluation.**" Employee data corresponding to the selected employee, i.e. the employee selected **for surplus evaluation**, is then retrieved. The retrieved employee data includes a skill group for the employee. The skill group is then used to retrieve an evaluation template, which is used to evaluate the employee who has been selected **for surplus evaluation**. Neither Band nor Haq is concerned with evaluating an employee selected as a potential surplus candidate.

The Examiner cites Band at paragraph 40 as teaching "selecting an employee for surplus evaluation." Applicants respectfully disagree. The cited section of Band discusses how to handle the situation where employees are allowed to request, or apply, for downsizing. Band notes that this creates a risk that the organization may lose employees who have critical skills. Band notes that one way to mitigate this risk is to identify employees with desired skills versus those employees who are candidates for departure. Employees with desired skills are then offered "appropriate incentives to ensure their retention." In other words, Band discusses identifying which employees have critical skills and then attempting to retain those employees. Presumably, those employees without such critical skills are then deemed "candidates for departure." However, Band does not teach or suggest "selecting an employee **for surplus evaluation**," as taught and claimed by Applicants. Band is not discussing selecting any particular employee, but rather, is discussing employees in terms of their skills, with regard to which groups of employees may be allowed to apply to leave. Further, Band does not disclose any type of **surplus evaluation**, especially with regard to a selected employee, as taught and claimed by Applicants. Therefore, Band does not teach or suggest "selecting an employee for surplus evaluation," as taught and claimed by Applicants in independent claims 1, 8, and 14.

The Examiner admits that Band does not disclose "retrieving employee data corresponding to the selected employee, wherein the employee data includes a skill group for the selected employee," "locating one of the evaluation templates corresponding to the retrieved skill group," and then "evaluating the selected employee using the located evaluation

template," as taught and claimed by Applicants. However, the Examiner cites Haq at col. 6, lines 13-17 as disclosing these aspects of Applicants' claims. Applicants respectfully disagree.

The cited section of Haq discloses a Suitability Skill Index Average (SSIA) which "gives a measure of the suitability of an employee for an assignment" (col. 6, lines 11-12). In order to determine if an employee is suitable for a particular job assignment, the employee's skills assessment form is assessed against a given skills template for a job function (col. 6, lines 12-16). Haq discloses a skills template that "basically identifies what skill levels are required and what is their importance for a job function" (col. 5, lines 33-35). A skills template "identifies the relevant importance of each skill (Weights) and the skill level (Index) required in each skill to perform a job function" (col. 5, lines 27-29). Skills templates "are used by managers to deploy employees with suitable skills for various assignments" (col. 5, lines 30-31). A skills template can also be used by an employee to plan his or her career development, by allowing the employee to assess what skills he or she needs to perform a job function (col. 5, lines 31-36).

The skills templates disclosed by Haq are used to quantitatively determine which employee is suited for a particular job (col. 1, lines 62-64). An employee's skills assessment form can be compared to a skills template to determine if the employee is suitable for a particular job assignment (col. 6, lines 11-16). Skills templates may also be used to set career goals and monitor employee performance (col. 2, lines 3). However, Haq does not teach or suggest "retrieving employee data" corresponding to an employee who has been

selected for surplus evaluation, where the retrieved "employee data includes a skill group," as taught and claimed by Applicants. Note that the employee assessments retrieved by Haq do not have anything to do with a surplus evaluation. Haq also does not teach or suggest locating an evaluation template corresponding to the retrieved skill group of the employee *who has been selected for surplus evaluation*, and then evaluating the employee, *who has been selected for surplus evaluation*, using the located evaluation template, as taught and claimed by Applicants.

Haq is concerned with matching employees to particular job assignments, and not with evaluating an employee who has been selected for surplus evaluation. Haq simply does not disclose using an evaluation template that corresponds to a particular skill group in order to evaluate an employee who has been selected for surplus evaluation, as taught and claimed by Applicants. Rather, the focus of Haq is to match employees to jobs. Therefore, Applicants respectfully submit that neither Band nor Haq nor a combination of the two teaches or suggests "retrieving employee data corresponding to the selected employee, wherein the employee data includes a skill group for the selected employee," "locating one of the evaluation templates corresponding to the retrieved skill group," and then "evaluating the selected employee using the located evaluation template," as taught and claimed by Applicants.

Based on the above, Applicants respectfully submit that independent claims 1, 8, and 14, and the claims which depend from them, are patentable over Band in view of Haq, and respectfully request that they be allowed.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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